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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/385,405      08/30/99      SCHMIDT

W      671.1.002CIP

EXAMINER

IM52/1002

WATOV & KIPNES PC  
P O BOX 247  
PRINCETON JUNCTION NJ 08550

POPOVICS, R

ART UNIT

PAPER NUMBER

1723  
DATE MAILED:

24  
10/02/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/385,405

Applicant(s)

Schmidt

Examiner

Popovic

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 9/19/01 (CPA Request)
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-5, 7-8, 10-27, 44 and 46-70 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-5, 7-8, 10-27, 44 and 46-70 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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## DETAILED ACTION

### *Continued Prosecution Application*

1. The request filed on September 19, 2001, for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/385,405 is acceptable and a CPA has been established. An action on the CPA follows.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5,7-8,10-27,44 and 46-70 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmidt (US 5,288,408).

4. In the '408 patent to Schmidt, one of the objects is stated to be:

Still another object of the present invention is to provide a recycled gelatin product with chemical and physical properties identical to virgin gelatin such that reuse may be successfully accomplished.

5. At column 3, the following is disclosed:

The soft elastic capsule-forming material will thus be used to enclose active ingredients in the form of powders, liquids or combinations thereof. Oils, such as vitamin A, vitamin E and beta-carotene, for example, are frequently encapsulated in the pharmaceutical industry. Additionally, other oils like mineral oil may be used to coat the outer surface of the gel-capsule during processing. Thus, it can be seen that the encapsulation waste product may have many components to be removed for reuse. In some instances, coloring agents and preservatives may also be incorporated into

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the encapsulation melt. Commonly used preservatives are methyl- and propylparabens and sorbic acid.

As stated above, present methods of encapsulation lose as much as 50% of the melt during processing, the balance of which is either discarded as a waste by-product or recycled. The latter option requires the removal of all of the above components with the exception of gelatin and glycerine. The present invention provides a novel and efficient method of accomplishing same without experiencing the shortcomings of the prior art.

6. At column 4, lines 22-31, it is disclosed that:

Next, the lower phase is hot filtered to remove any remaining traces of oil or other contaminants. Stainless steel filtration equipment may be employed such as a plate filter, or a coated plate filter like, for example, a Sparkler filter. Alternatively, nutche filters of the Rosenmund type or cartridge filters may be used for the purpose. Here again, the residue may be recaptured for further separation and purification if desired although the amounts involved at this point may not warrant the effort.

7. Claim 6 teaches:

6. The process for recovering and purifying waste gelatin and glycerine of claim 1, wherein the step of hot filtering said aqueous gelatin/glycerine solution is accomplished by use of one of the following filters: (a) a plate filter; (b) a coated plate filter; (c) a nutche filter; or (d) a cartridge filter.

8. Claim 20 teaches:

20. The apparatus of claim 12 wherein said means for hot filtration is a cartridge filter.

9. In order to remove ***"all of the above components,"*** including ***"traces"*** of ***"coloring agents,"*** ***"oils and other contaminants,"*** to attain a ***"recycled gelatin product with chemical and physical properties identical to virgin gelatin,"*** any ***"cartridge filter"*** used would necessarily have the ability, regardless of the filtration process label placed upon it, to accomplish this task. That is to say that any ***"cartridge filter"*** used would have inherently possessed the ability to accomplish the stated objective. The '408 patent is clear, that a ***"cartridge filter"*** may

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be used ***“to remove any remaining traces of oil or other contaminants”*** from the aqueous/lower phase!

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-5,7-8,10-27,44 and 46-70 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt et al. (U.S. Patent No. 5,288,408).

Schmidt et al. disclose a method of gelatin recovery. As illustrated in Fig. 1, waste material is dissolved with a solvent in an agitated tank and separated into an aqueous/lower phase stream and an upper/organic phase stream. The resultant aqueous phase stream is then subjected to heat and hot filtered, ***“to remove any remaining traces of oil or other contaminants.”*** A resultant gelatin/glycerine filtrate is then heated and subjected to vacuum distillation in order to concentrate (i.e., dewater) the resultant, purified filtrate. The recovered gelatin and glycerine may then be immediately re-used (col. 2, lines 33-35 & col. 5, lines 5-10). Beyond disclosing the use of a “cartridge filter” as one possible type of filter to be used, the ‘408 patent does not go into the details of the pore size, material of construction, etc., of a “cartridge filter” which would be suitable for the stated purpose. Obviously, no such details were provided, since Schmidt et al. knew that the selection of a such filter would have been well within the purview of the skilled

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artisan. Indeed, numerous filters existed prior to issuance of the '408 patent which could have handled the separation of "trace" amounts of oil, or "other contaminants" from a liquid stream.

The various temperature/pressure ranges, dilution volume ranges, etc. absent a showing of unexpected results or criticality specifically associated therewith, are considered obvious over the references as applied above.

### ***Claim Rejections - 35 USC § 112***

12. Claims 1-5,7-8,10-27,44 and 46-70 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: heating to, and maintaining at temperature to prevent solidification or effect dissolution.

### ***Response to Amendment***

13. Applicant's After-Final Amendment of April 02, 2001 remains ***"unentered."***

14. The Declaration under 37 CFR 1.132 filed August 24, 2001 is insufficient to overcome the rejection of claims based upon the rejection as set forth in the last Office action because: it fails to provide sufficient probative evidence to establish the inoperability of the '408 patent, unexpected results, or commercial success. Moreover, it confuses the standard of ***obviousness***, as in ***"would have been obvious"*** with an actual or in-fact standard, as in ***"was obvious."*** Finally, economic considerations are not a factor when determining obviousness.

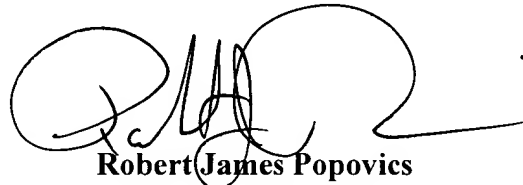
In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (e.g., "milky white

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appearance,” (of prior art) when claim 1 recites “higher purity,” and “commercial scale” ) are not recited in the rejected claim(s). That is to say, that many of the arguments presented in the Declaration are not commensurate in scope with the pending claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Robert Popovics whose telephone number is (703) 308-0684, and who can normally be reached at this number from 9:30 A.M. through 6:00 P.M. (EST) M-F.



**Robert James Popovics**  
**Primary Examiner**  
**Art Unit 1723**

ryp  
September 29, 2001